

The opinion in support of the decision being entered today  
was *not* written for publication and  
is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* RANDALL A. ADDINGTON, W. ROBERT ADDINGTON and  
W. ROBERT ADDINGTON II

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Appeal 2006-3338  
Application 09/396,530  
Technology Center 3700

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Decided: February 28, 2007

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Before JENNIFER D. BAHR, ROBERT E. NAPPI, and  
LINDA E. HORNER, *Administrative Patent Judges*.

NAPPI, *Administrative Patent Judge*.

## DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 of the final rejection of claims 3, 4, and 14 through 30. For the reasons stated *infra* we will not sustain the Examiner's rejection of these claims.

## INVENTION

The invention is directed to a method of using a finger shield, attached to a bowler's hand, to control the release of a bowling ball. See pages 4, 5 and 23 through 26 of Appellants' specification. Claim 14 is representative of the invention and is reproduced below:

14. A method of using a finger pad shield placed in contact with the finger pad of a bowler's finger inserted into a finger hole of a bowling ball, to reduce the pressure on the finger pad when releasing said bowling ball from said bowler's finger and to improve a bowler's control over a direction or spin on a bowling ball, when lifting the bowling ball to impart spin and velocity, at release, comprising the steps of:

- a. placing a finger pad shield having a first surface, and a second surface opposed to said first surface, on a finger pad of a bowler, with said first surface in contact with said finger pad of a bowler and forming a contact area made between said finger pad of a bowler and said first surface of said finger pad shield;
- b. inserting said finger pad shield, in a finger hole of a bowling ball;
- c. said step b, of inserting said finger pad shield in said finger hole of a bowling ball, including the step of placing said second surface of said finger pad shield in contact with an interior surface of said finger hole of a bowling ball;

d. releasing said finger pad of a bowler and said finger pad shield from said finger hole of a bowling ball by applying a first force from said finger pad of a bowler in a first direction against said first surface of said finger pad shield, through said finger pad shield to said second surface of said finger pad shield, against said interior surface of said finger hole of a bowling ball, to lift said bowling ball and producing a second force in a second direction, from said interior surface of said finger hole of a bowling ball, against said second surface of said finger pad shield;

e. said step d, of releasing said finger pad of a bowler and said finger pad shield from said finger hole of a bowling ball, includes the step of receiving said second force in said second direction, from said interior surface of said finger hole of a bowling ball, against said second surface of said finger pad shield, through said finger pad shield to said first surface of said finger pad shield and over said contact area made between said finger pad of a bowler and said first surface of said finger pad shield; and

f. said step e, of receiving said second force in said second direction from said interior surface of said finger hole of a bowling ball, against said second surface of said finger pad shield, includes the step of distributing said second force in said second direction from said interior surface of said finger hole of a bowling ball, against said second surface of said finger pad shield, over said contact area made between said finger pad of a bowler and said first surface of said finger pad shield, for reducing a pressure over said contact area made between said finger pad of a bowler and said first surface of said finger pad shield, produced by said second force, in a second direction from said interior surface of said finger hole of a bowling ball, against said second surface of said finger pad shield.

## REFERENCE

The reference relied upon by the Examiner is:

Marinese                    US 3,046,561                    Jul. 31, 1962

## REJECTION AT ISSUE

Claims 3, 4, and 14 through 30 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Marinese. The Examiner's rejection is set forth on pages 3 through 5 of the Answer. Throughout the opinion we make reference to the Brief and Reply Brief (filed August 25, 2004 and January 4, 2005 respectively), and to the Examiner's Answer (mailed November 30, 2004) for the respective details thereof.

## ISSUES

Appellants contend that the rejection under 35 U.S.C. § 102(b) is in error as Marinese does not teach all of the limitations of independent claims 14, 21 and 23. Appellants argue that one of the claimed features not taught is the use of a finger shield when lifting to impart spin and velocity while releasing the ball.

The Examiner in response contends that the rejection is proper. The Examiner states that Marinese teaches a finger pad shield and that the finger pad shield carries out the claimed method steps during normal use. Further, the Examiner states “[u]nder the principles of inherency, if a prior art

device, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art device.” (Answer, page 3.)

Thus, the issue presented to us is whether the use of the finger pad of Marinese inherently performs the claimed method steps including use of a finger shield when lifting to impart spin and velocity while releasing the ball as recited in the independent claims.

#### FINDINGS OF FACT.

Marinese teaches a ring that a bowler wears around the thumb. The ring has a ridged outer member and an inner cushioning member which conforms to the finger. See col. 2, ll. 46-50 and col. 3, ll. 3-5. The ring is carried on the thumb of the bowler and is “responsive to adequate thumb pressure in the control of the bowling ball, [and] will enable the release of the bowling ball without frictional drag.” See col. 1, ll. 55-61 and col. 3, ll. 21-33. We note that Marinese discusses control of the bowling ball and release of the bowling ball separately, but does not discuss controlling the bowling ball during the release of the bowling ball. Further, we find no discussion in Marinese of using the thumb or the thumb with the thumb ring to impart spin and velocity to the bowling ball. Additionally, we do not find that Marinese discusses using the ring on any finger other than the thumb.

## PRINCIPLES OF LAW

Office personnel must rely on Appellants' disclosure to properly determine the meaning of the terms used in the claims. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 980, 34 USPQ2d 1321, 1330 (Fed. Cir. 1995). “[I]nterpreting what is *meant* by a word *in* a claim ‘is not to be confused with adding an extraneous limitation appearing in the specification, which is improper.’” *In re Cruciferous Sprout Litigation*, 301 F.3d 1343, 1348, 64 USPQ2d 1202, 1205 (Fed. Cir. 2002) (emphasis in original) (citing *Intervet America, Inc v. Kee-Vet Laboratories, Inc.*, 887 F.2d 1050, 1053, 12 USPQ2d 1474, 1476 (Fed. Cir. 1989)). “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.’ ‘Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

## ANALYSIS

Claim 14 recites “A method of using a finger pad shield placed ... to improve a bowler's control over a direction or spin on a bowling ball, when lifting the bowling ball to impart spin and velocity, at release” and “releasing said finger pad ... to lift said bowling ball .” Thus, we find that independent claim 14 recites using the finger pad shield when releasing the

ball to “lift” the ball. The claim also recites that to “lift” the ball is to impart spin and velocity. Independent claims 21 and 23 recite similar limitations.

In contrast to the Appellants’ invention wherein the finger pad shield is disposed on one of the four other fingers and not the thumb, Marinese discloses use of a thumb ring. We do not find that the Examiner has shown that use of Marinese’s thumb ring during release of the ball inherently allows the bowler to “lift” (impart spin and velocity) to the ball. As discussed *supra* we find that Marinese teaches that use of the thumb protector assists the user in controlling the ball, and provides a frictionless release of the ball. We do not find that Marinese discusses providing control over the ball as it is being released. Nor, do we find that the Examiner has provided evidence that the thumb of a bowler necessarily, imparts spin and velocity during the release of a bowling ball. Thus, we do not find that Marinese teaches implicitly, or through the principles of inherency, the limitations of independent claims 14, 21 and 23.

## CONCLUSION

We consider the Examiner’s rejection of claims 3, 4, and 14 through 30 under 35 U.S.C. § 102 (b) to be in error as we do not find that Marinese inherently performs the claimed method steps including use of a finger shield when lifting to impart spin and velocity while releasing the ball.

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ORDER

For the forgoing reasons, we will not sustain the Examiner's rejection of claims 3, 4 and 14 through 30 under 35 U.S.C. § 102(b). The decision of the Examiner is reversed.

REVERSED

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